

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT:	Terrence SICK et al.	GROUP:	3693
APPLICATION:	09/965,071	EXAMINER:	S. Chandler
FILED:	September 27, 2001	CONFIRMATION:	2718
FOR:	COMPUTER-BASED SYSTEM AND METHOD FOR SEARCHING AND SCREENING FINANCIAL SECURITIES AND RELEVANT INTELLECTUAL PROPERTY		

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

LETTER ACCOMPANYING APPEAL BRIEF

In response to the Notice of Panel Decision from Pre-Appeal Review (dated November 2, 2007) Appellants submit herewith an Appeal Brief. No oral hearing is presently requested, and Appellants respectfully request that the Board render a decision based upon the parties written submissions.

Appellants hereby petition for a one (1) month extension of time pursuant to 37 CFR 1.136(b) for the submission of this Brief. In the event any fees are required in association with this submission, including fees for extensions of time pursuant to 37 CFR 1.136(b) Appellants hereby petition for such an extension and authorization is hereby provided to charge such fees or additional amounts to the Basch & Nickerson LLP Deposit Account 50-2737.

Respectfully submitted,


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APPELLANTS' BRIEF ON APPEAL

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1. REAL PARTY IN INTEREST

Technology Innovations, Inc. by assignments from inventors Michael L. Weiner and Eric Schneider, dated October 4, 2007 and October 18, 2007, respectively, and Terrence Sick.

2. RELATED APPEALS AND INTERFERENCES

NONE.

3. STATUS OF CLAIMS:

Claims 1 - 17 remain rejected in the application. The rejections of claims 1 -17 are appealed herein.

4. STATUS OF AMENDMENTS:

No amendment after final rejection was submitted. The claims stand as last amended by right by Appellants' submission on March 15, 2007, prior to the final rejection.

5. SUMMARY OF CLAIMED SUBJECT MATTER:

As set forth in the specification (e.g., page 3) and claims,

"The invention integrates both financial search criteria and intellectual property search criteria into a single user interface. The present invention filters the search results of public companies having patent portfolios. The invention filters the search results of patents assigned to only public companies. The present invention filters search results of network resources that correspond only to patent information. The invention automatically broadens a search request until a search result is found in response to determining that a previous search request does not have a search result."

Appellants further urge the distinctiveness and advantages of the present invention, including the advantages, as noted above and as specifically enumerated in the appended claims. Appellants respectfully contend that the various features set forth above, as claimed and supported by the disclosure of the present application, provide significant advantages to users of such systems – particularly a system which helps investors screen out investment opportunities by combining fundamental financial search criteria with that of patent search criteria such as intellectual property holdings, patents issued and the like.. Appellants further submit the following information in support of the claimed features of the present application:

Independent Claim 1. Claim 1 is directed to a method of searching a financial database in an on-line financial screening service and an intellectual property database, both databases including data for a plurality of companies, in order to find securities matching user search criteria and relevant intellectual property, wherein the users access the database over the Internet, as depicted, for example, in FIGS. 1A – 1D and described at pages 8 – 11 of the Specification. The recited method includes searching the database for records matching financial search criteria defined by a user (e.g., FIGS. 3A, 3B; pp. 12-13 of Specification); relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one (e.g., FIG. 7, see 725); and reporting the matching records to the user. For example, the Specification teaches an improved financial query interface for accessing patent and financial information in accordance with the present invention. Financial search criteria 410 may be selected from a user interface element. Financial search criteria may include the selection of parameters such as Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio. (e.g., FIG. 4A and as described at pp. 13, line 29 – 14, line 6).

Dependent Claim 2. Claim 2 further defines the search criteria of claim 1 as suitable for being delimited between a minimum and maximum. An example of such a limitation is also described at , p. 14, lines 3- 6), where the Specification states “[i]t is also conceivable that one or more of the search criteria specified, particularly those employed in the financial query, may be delimited by maximum and/or minimum values. For example, a stock price trading at between greater than \$20 and less than \$50.”

Independent Claim 3. Claim 3 is directed to a method for screening financial investment opportunities in an on-line service, comprising various steps. The steps include searching a financial database, including data for a plurality of companies, for data records associated with at least one company based upon a financial search criteria and retrieving the results; searching an intellectual property database, including data for a plurality of companies, for data records associated with the at least one company based upon an intellectual property search criteria and retrieving the results thereof; combining the results of the financial database searching step and the intellectual property database searching step to determine common results on a company basis; and depicting the combined results. Such steps are disclosed, for example, at pp. 12-13 and are depicted in the block diagrams and flowcharts of FIGS. 3A – 3C as well as later figures. In one embodiment, described beginning at p. 13, line 6, “a network access apparatus 110, servlet, ... receives and parses a search request in step 240 [t]he query interface 310 serves as a front end for accessing both a patent database 178 and financial database 180, particularly when such databases are supplied by separate vendors.” And the results, if any, are provided in step 250 to the client system 110. The assignee/ticker database 176 is consulted as needed to generate results that correspond to both the patent 178 and financial 180 databases. For example, the step of combining the results of the financial database searching step and the intellectual property database searching step, further comprises accessing an assignee/ticker database to determine linkages between the

financial database and the intellectual property database on a company by company basis (see e.g., p. 13, lines 14-27).

Dependent Claims 4 and 5. As set forth at p. 16, lines 1-9 and in FIG. 7 (see test step 715) the number of common results are checked to determine if the number is greater than zero, and if not relaxing the search criteria (720) employed in at least one of the searching steps and rerunning the searches (245) so as to obtain a non-zero number of common results. And, as set forth at p. 16, lines 10-24, "[i]t is also contemplated that the step of relaxing the search criteria may be accomplished without user intervention" as recited in claim 5.

Dependent Claim 6. Claim 6 is dependent from claim 3 and further recites maintaining the financial database data records and the intellectual property database records, wherein the step includes periodically launching an automated search of network resources to locate and update financial and intellectual property information; and storing the updated information in the respective database. These limitations are discussed, for example, at p. 15, lines 12-30.

Dependent Claim 7. Dependent from claim 6, claim 7 sets forth various types of information that may be updated and support for the recited group is found at p. 15, lines 17-30.

Dependent Claim 8. The method of claim 3 is further modified in claim 8, which recites a further step, the step of constructing a search query having both financial and intellectual property search criteria. At p. 13, lines 1-3 and 6 – 13, the Specification teaches that a "network access apparatus 110, ...receives and parses a search request in step 240 by using a single query interface 310 that includes the selection of both financial and patent search criteria."

Dependent Claim 9. The limitations of claim 9, dependent from claim 8, are described, for example, at p. 13, lines 3-4, where the Specification indicates "the

step of constructing such a search query is facilitated by the step of displaying a search construction interface to a user (e.g., Figure 4A)."

Dependent Claim 10. Claim 10 indicates that combining the results further comprises accessing an assignee/ticker database to determine linkages as is disclosed at p. 13, lines 24 - 28.

Independent Claim 11. This independent claim is directed to a system as depicted, for example, in FIGS. 1A – 1D, which depict a system for screening financial investment opportunities. The figures are further described at p. 8, line 29 – page 11, line 29. The system comprises a computer platform (e.g., 110/120) responsive to user input including access to at least a financial database including data records (e.g., p. 10, lines 10-13) associated with a plurality of companies and an intellectual property database including data records associated with a plurality of companies. Reference to plural companies is found throughout the application, and in particular at p. 12, lines 30-34, p. 14, lines 7-11, etc. Programmable search software such as programs 112 are operable on computers 110/120, for searching the financial database (e.g., 180, 215) for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof for storage in a first memory, and an intellectual property database (e.g., 174, 225) for data records associated with the at least one company based upon an intellectual property search criteria. The search analysis software, operable by computer 110/120 combines and processes the results of searches to determine common results as described at p. 12, line 30 – p. 13, line 4), and the common results are displayed as illustrated in FIG. 8B, for example as described at p. 16, lines 24-29 (also see p. 9, lines 10-23).

Dependent Claim 12. Claim 12 is dependent from claim 11, and further characterizes the computer platform as a client and a server (e.g., FIG. 1A) interconnected by a network, and where the financial database and the intellectual

property database are stored on devices accessible through the server as described at p. 8, lines 14 – 19 and p. 11, lines 4-19.

Dependent Claim 13. Also dependent from claim 11, claim 13 recites means for automatically relaxing search criteria as described, for example, at p. 15, line 31 through p. 16, line 24.

Dependent Claim 14. The system of claim 11 is further defined in dependent claim 14, and the recited limitations for the financial and patent databases are described in detail at p. 13, line 29 – p. 14, line 6 and p. 14, lines 12-25, respectively.

Dependent Claim 15. Dependent claim 15, also dependent from claim 11, recites a display of at least one user-selectable data item to assist with the construction of a search query which is described relative to FIG. 3B, and client 110 at p. 12, lines 20-29.

Independent Claim 16. The method for processing a search request as set forth in claim 16 is depicted, for example, as set forth above relative to claim 1 and beginning at p. 13, line 29. There the Specification discloses an improved financial query interface for accessing patent and financial information, where Financial search criteria 410 are selected from a user interface element. In FIG. 5B, described beginning at p. 14, line 30, when search results having identifiers are retrieved in step 245, step 520 determines whether the search request includes patent criteria. When patent criteria is requested as part of a search then search results are filtered in step 525 based on the patent criteria, and results are provided in step 250.

Independent Claim 17. The disclosed method finds support, for example, in FIGS. 1A-1D, 4A, and at pages 13-14, as well as those portions of the specification and figures as set forth above. For example, beginning at p. 13, line 29, the Specification discloses an improved financial query interface for accessing patent and financial information, where Financial search criteria 410 are selected from a user interface element.

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

The grounds for rejection remain as set forth in the Final Office Action of May 4, 2007.

Claims 3-6, 8, 9, 11-13 and 15-17 remain rejected under 35 USC §102(e) as being anticipated by Rivette et al., US Patent 5,991,751 (hereinafter "Rivette").

Claim 10 remains rejected under 35 USC §103(a) as being unpatentable over Rivette, with the Examiner taking Official Notice.

Claims 1, 2, 7 and 14 remain rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black et al., US Patent 6,012,042 (hereinafter "Black").

7. ARGUMENT:

Further to Appellants arguments submitted in Request for Pre Appeal Brief Conference, the following arguments are responsive to the Final Office Action. Moreover, in the following arguments Appellants set forth specific arguments in traversal of the rejections of both independent and dependent claims and request that the Board not consider those dependent claims specifically set forth as standing or falling with the independent claims, but based upon their own merits.

Several questions are presented in this appeal:

First, whether claims 3-6, 8, 9, 11-13 and 15-17 were properly rejected under 35 USC §102(e) as being anticipated by Rivette, including whether the rejection properly establishes *anticipation* of each and every element recited in the rejected claims.

Second, whether Claim 10 was properly rejected under 35 USC §103(a) as being unpatentable over Rivette, with Official Notice, including

- (a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness;
- (b) whether the rejection under 35 USC §103(a) improperly relies upon information that has not been established as having been available prior to Appellants' application; and
- (c) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

Third, whether claims 1, 2, 7 and 14 were properly rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black, including

- (a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness; and
- (b) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

Appellants respectfully submit that this invention is unique and has extensive application and utility.

Rejection Under 35 U.S.C. §102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As further set forth in MPEP §2131, to anticipate a claim, a reference must teach every element recited in the claim. As the following discussion will illustrate, the Examiner failed to establish as the basis for the rejection, where each recited limitation was taught by the reference relied upon.

(I) Were claims 3-6, 8, 9, 11-13 and 15-17 properly rejected under 35 USC §102(e) as being anticipated by Rivette?

With respect to **independent claims 3, 11, 16 and 17**, Rivette is directed to a system, method, and computer program product for patent-centric and group-oriented data processing, and discloses a system for evaluating the value of a corporation's patent portfolio. In the "Overview of the Invention" starting at col. 9 (bottom), Rivette describes "evaluating the value of the corporation's patent portfolio (represented as part of the patent information 204)" (col. 10, lines 50-52). Rivette is an example of a system that processes patent information for what is indicated to be a single corporation (see e.g., "a corporate entity" col. 3, line 63; "the corporation" col. 4, line 8). As Appellants have maintained, Rivette does not disclose or suggest the management of patent (intellectual property) and non-patent (financial) information from multi-company databases by referencing such information to make a decision. Such limitations were previously added wherein reference to both databases were amended to specifically recite that the respective databases included "data for a plurality of companies." Rivette simply fails to teach such limitations and instead indicates that enterprise server 314 is designed for a customer (col. 16), where the customer is a "customer corporate entity" (col. 15, lines 50-51), that the data is that which "the customer maintains" (col. 16, line 35) for the company, and as described at col. 17, lines 17-20, the patent database 614 is the "customer's repository of

patents.” Similarly, at col. 21, line 58 – col. 22, line 6, Rivette characterizes the financial databases 638 as storing financial information pertaining to the customer’s business. Hence, the financial database of Rivette is not one that includes data for a plurality of companies as presently set forth in the rejected claims. While Rivette refers to information about competitor companies, it does not appear to contemplate the searching of financial and intellectual property databases having data for a plurality of companies as is presently recited in the amended independent claims, for example, claims 3, 11, 16 and 17.

Referring to the “Response to Argument” (Final Office Action, p. 17), the Examiner first suggested that the limitation of multiple or plural company data in the databases is not claimed, but then states that Rivette discloses the claimed subject matter. The Examiner is believed to be mistaken and to have mis-characterized the teachings of Rivette. First, although the Examiner urges that such a limitation is taught by Rivette, the Examiner fails to identify any support for such teaching, resorting to conjecture (“at a minimum that database would hold ...”) to urge that data for other companies would have to be included in the database. At best, this is an unsupported argument for inherency (and no necessity of including multiple company data has been proffered). More likely, the Examiner’s reliance on the teaching at col. 10, lines 17-22 is in error, as there is no suggestion that databases include financial data for a plurality of companies or intellectual property data for a plurality of companies. Absent a specific teaching of the limitations set forth in the claims, as noted by the cases above, Appellants respectfully submit that all limitations of independent amended claims 3, 11, 16 and 17 are not taught and, therefore, cannot be anticipated by Rivette. The Board is respectfully requested to reverse the Examiner’s rejection relative to independent claims 3, 11, 16 and 17, and dependent claims 12 and 15.

As for the rejection of **claim 4**, the dependent claim recites “analyzing the number of common results on a company basis to determine if the number is greater than zero, and if not relaxing the search criteria employed in at least one of the searching steps and rerunning the searches so as to obtain a non-zero number of common results.” The Examiner continues to urge that Rivette teaches the claim limitations at col. 25, line 39 – col. 30, line 6. Appellants have again reviewed this portion of Rivette in detail and are unable to determine where such a teaching is found, either expressly

or impliedly. Accordingly, for this reason, Appellants respectfully submit that claim 4 is not anticipated and requests that the Board reverse the Examiner's rejection thereof.

Claim 5, dependent from claim 4, indicates that relaxing the search criteria is accomplished without user intervention. Curiously, the Examiner again relies on reference to col. 25, line 39 – col. 30, line 6 of Rivette as the basis for such a teaching. Of course, if Rivette fails to teach the limitations of claim 4 in cols. 25-30, it also could not teach the further limitations of claim 5. Accordingly, Appellants maintain that the limitations of dependent claim 5 are not anticipated, and that the rejection thereof should be reversed as well.

Dependent **claim 6**, also dependent from claim 3, sets forth the further step of maintaining the financial database data records and the intellectual property database records, including periodically launching an automated search of network resources to locate and update financial and intellectual property information, and storing the updated information. Once again, Appellants are unable to identify just what the Examiner relies upon in cols. 16-22 or 25 – 30 as teaching the automated search of network resources to update the databases, and the storage of such information. Absent a particular teaching of the recited limitation, Appellants respectfully urge that claim 6 is not anticipated and request reversal of the rejection by the Board.

The limitations of **claims 8 and 9**, also dependent from claim 3, recite the further step of constructing a search query having both financial search criteria and intellectual property search criteria. Once again the Examiner relies on Rivette cols. 25 – 30 as the basis for the alleged teaching. And, once again, Appellants respectfully maintain that Rivette fails to teach such a limitation as has been urged by the Examiner. Hence, the Board is respectfully requested to reverse the rejection of claim 8. For the reasons set forth relative to claim 8, claim 9 is also urged as having been erroneously rejected as anticipated by Rivette and reversal of the rejection is requested.

Claim 13, dependent from claim 11, indicates that relaxing the search criteria is accomplished automatically. Curiously, the Examiner again relies on reference to col. 25, line 39 – col. 30, line 6 of Rivette as the basis for such a teaching. Rivette

fails to teach the limitations of claim 13 in cols. 25-30. More specifically, Rivette fails to teach "automatically relaxing search criteria employed by the programmable search software so as to obtain a non-zero number of search results." Accordingly, Appellants maintain that the limitations of dependent claim 13 are not anticipated, and that any rejection thereof based upon Rivette should be reversed as well.

In light of the arguments above, the Board is respectfully urged to answer the first question in the negative and to reverse the Examiner's rejection of claims 3-6, 8, 9, 11-13 and 15-17.

Rejection Under 35 U.S.C. §103

Under section 35 U. S. C. §103, the Patent and Trademark Office must make out a case of *prima facie* obviousness and it is incumbent upon Appellant to rebut that case with objective evidence of non-obviousness, *In re Tiffin and Erdman*, 170 USPQ 88 (CCPA, 1971). In determining the propriety of the Patent and Trademark Office's case of *prima facie* obviousness, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him (her) to make the proposed substitution, combination or other modification.

It is well known that a determination of obviousness rests upon the answers to the factual inquiries set forth in *Graham v. John Deere Co.*, 383 US 1 (US Sup. Ct. 1966); scope and content of the prior art; differences between the prior art and the claims at issue; and level of ordinary skill in the art. As recently set forth in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007), the Supreme Court reiterated that the operative question, when considering obviousness of a combination of known elements, is "whether the improvement is more than the predictable use of prior art elements according to their established functions" *Id.* at 82 USPQ2d 1396. In *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987), the court stated that "[w]ith the involved facts determined, the decision maker confronts a ghost, i.e. "a person having ordinary skill in the art", not unlike the "reasonable man" and other ghosts in the law. To reach a proper conclusion under section 103, the decision maker must step backward in time and into the shoes worn by that "person" when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether the patent challenger has convincingly established, 35 U.S.C. 282, that the claimed invention as

a whole would have been obvious at that time to that person. 35 U.S.C. §103. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts. If itself a fact, it would be part of its own foundation. . . . a prior patent must be considered in its entirety, i.e., as a *whole*, including portions that would lead away from the invention in suit." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990; *emphasis added*)). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 1432.

Finally, the Examiner may not use the Appellant's disclosure as a recipe for selecting portions of the "prior art" to construct Appellant's claimed invention. A piecemeal reconstruction of the prior art patents in light of Appellant's disclosure is not a basis for a holding of obviousness, *In re Kamm et al.*, 172 USPQ 298 (CCPA, 1972). The mere fact that the prior art could have been modified does not make the modification obvious unless the prior art suggested the desirability of such a modification, *In re Gordon*, 221 USPQ 1125, (Fed. Cir. 1984); *Jones v. Hardy*, 220 USPQ 1021, (Fed. Cir. 1984). Moreover, this teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the Appellant's disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). As the KSR court reiterated the analysis under 35 U.S.C. §103 must be made explicit, citing the holding in *Kahn* that stated, "'rejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR at p. 13*, 82 USPQ2d at 1396; citing *In re Kahn* 441 F. 3d 977, 988 (CA Fed. 2006). Absent articulated reasoning and at least some rational underpinning to support the conclusion, *prima facie* obviousness is not established.

(II) Was claim 10 properly rejected under 35 USC §103(a) as being unpatentable over Rivette, with Official Notice?

As previously submitted by Appellants, *prima facie* obviousness has not been established, and the rejections have been respectfully traversed. Moreover, although

Appellants have addressed the various rejections, the following discussion sets forth the bases upon which the rejections are traversed.

(a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness;

The distinctions over Rivette are generally set forth above relative to claim 3, from which claim 10 indirectly depends, and claim 4, from which claim 10 directly depends. Furthermore, Appellants continue to urge that the rejection of claim 10 is improper and that *prima facie* obviousness has not been established. Accordingly, the Board is respectfully requested to reverse the rejection of dependent claim 10.

To establish *prima facie* obviousness, three criteria must be met. First, there must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings of references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, as previously urged by Appellants, Official Notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known at the time of invention.

Appellants previously urged that the Examiner had not established *prima facie* obviousness as no teaching was identified as suggesting "accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis" as recited in claim 10. The Examiner acknowledged that Rivette did not teach such a step, but urged Official Notice thereof.

(b) whether the rejection under 35 USC §103(a) improperly relies upon information that has not been established as having been available prior to Appellants' application; and

In response to Appellants' traverse of the Official Notice, for the first time in the Final Office Action which is appealed from, the Examiner produced what is alleged to be "documentary evidence" to support a position that "it is old and well-known that publicly available financial and intellectual property data concerns assignee and ticker data." Appellants again traverse the Official Notice as not having been demonstrated by adequate "documentary evidence" where the "documents" provided are search results for an on-line search apparently conducted by the Examiner in April 2007 (well after Appellants' filing date of Sept. 27, 2001) for alleged news articles with one or more of various words such as ticker, assignee, etc. Furthermore, none of the articles identified in the search results has been made of reference in the instant application or provided in support of the "Official Notice." The Examiner's search apparently failed to identify a particular prior art document that indeed supports the allegation that that "it is old and well-known that publicly available financial and intellectual property data concerns assignee and ticker data" as alleged.

(c) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

Furthermore, the "documents" alleged in support of the Official Notice do not teach or suggest the recited claim limitation (claim 10) that requires "accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis." Accordingly, Appellants continue to traverse the Official Notice and/or the Examiner's "documentary evidence" as insufficient to establish any teaching or suggestion of the limitations expressly set forth in claim 10. Absent a teaching of accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis, *prima facie* obviousness has not been established. Nor has the Examiner established, as required for a rejection under §103(a), a suggestion or motivation to modify or to combine Rivette with the alleged "documentary evidence." While various sections of Rivette are referred to, none is identified to suggest accessing an assignee/ticker database to determine linkages as

alleged by the Examiner. That the Examiner "concludes" that it would have been obvious to use an assignee/ticker database, without such a limitation being disclosed in a reference is a clear indication that the Examiner has failed to support his conclusion. Accordingly, claim 10 is respectfully maintained to be patentable over Rivette and the Board is respectfully requested to reverse the rejection thereof.

(III) Whether claims 1, 2, 7 and 14 were properly rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black?

As Appellants urged previously, *prima facie* obviousness has not been established, and the rejections of claims 1, 2, 7 and 14 have been traversed. Moreover, the following discussion sets forth the various bases upon which the rejections are ripe for reversal by the Board.

(a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness;

As for amended claim 1, the distinctions over Rivette are generally characterized above relative to similar independent claims. With respect to claim 1, Appellants respectfully submit that the additional limitations that the databases include data for a plurality of companies are not taught or suggested by Rivette or Black. In the Response to Arguments, the Examiner indicated that the amendment to the preamble has not been given patentable weight. Appellants respectfully submit that the limitation as to the recited database is not a limitation as to purpose or intended use. Rather, the limitation is directed to the structure of the claimed invention (further defining the database) such that "when read in the context of the entire claim, recites limitations of the claim, [and] ... should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999) (*emphasis added*).

(b) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

Moreover, the rejection indicates that the limitation of "relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one" is taught

somewhere between columns 25 and 30 of Rivette (Office Action p. 11 top, and Final Office Action p. 22). Appellants remain unable to identify just what the Examiner relied upon for teaching such a limitation, and respectfully suggest that the Examiner has failed to establish *prima facie* obviousness by identifying support for the alleged teaching (as noted above, the prior art reference or combination must teach or suggest all the claim limitations). This is as much as acknowledged by the Examiner's reliance on an unsupported description of a search methodology set forth in detail at p. 22 of the Final Action rather than a specific reference to Rivette or other prior art. Notably, the Examiner's own examples at p. 22 of the Final Office Action suggest that indeed Rivette's teachings themselves may likely be directed at narrowing the search of the company's database and do not necessarily give rise to the Examiner's interpretation. Similarly unpersuasive is the Examiner's continued reliance on the terms "iterative" (searching within a prior search result group; col. 26, lines 25-28), "search strategies" ("keyword, keyword phrase, keyword phrases with Boolean, ..."; col. 26, lines 29-33), and "manipulate" ("manipulate and process the search results"; col. 26, line 42), which also fail to teach relaxation of search criteria as recited in independent claim 1. Hence, Appellants continue to traverse the rejection of independent claim 1, and claim 2 dependent therefrom, and respectfully request the Board to reverse the rejection thereof.

As to the rejection of dependent **claims 7 and 14**, the rejection fails to set forth a basis for teaching of all limitations in the independent claims, and Appellants thereby maintain that the rejection is incomplete on its face. Claims 7 and 14, respectively dependent from claims 6/3 and 11, recite items (as Markush groups) of financial data and intellectual property data. As with claim 1, the Examiner relies upon the combination of Rivette and Black, and urges, for example, that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Rivette by adopting the teachings of Black to provide in an on-line service, a method for screening financial investment opportunities..." (Final Office Action, p. 14, bottom). Such a basis is unsupported and is urged as contrary to the teachings of Rivette, which are directed toward patent and group centric data processing (see Abstract; col. 1) for a corporate entity or organization; whereas Black is directed to analysis of securities. Appellants respectfully urge that one of skill in the art would not have been motivated to make the proposed combination or modifications, and that the Examiner's basis for the combination lack any articulated

reasoning or rational underpinning to support the legal conclusion of obviousness. Hence, Appellants renew their traversal of the rejection and respectfully urge the Board to overturn the rejection of dependent claims 7 and 14.

Conclusion

As set forth above, claims 3-6, 8, 9, 11-13 and 15-17 were improperly rejected under 35 USC §102(e) as being anticipated by Rivette as the rejection failed to establish anticipation of each and every element recited in the rejected claims. And, claim 10 was improperly rejected under 35 USC §103(a) as being unpatentable over Rivette with Official Notice as the rejection failed to establish or properly document the support for such notice. Furthermore, claims 1, 2, 7 and 14 were also improperly rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black.

In light of the various arguments set forth above, Appellants respectfully submit that all of the questions presented should be answered in the negative, that all rejections set forth should be reversed, and that Appellants' pending claims should be indicated as allowable.

Respectfully submitted,



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8. CLAIMS APPENDIX:

The following are the appealed claims:

1. In an on-line financial screening service, a method of searching a financial database, including data for a plurality of companies, and an intellectual property database, including data for a plurality of companies, in order to find securities matching user search criteria and relevant intellectual property, wherein the users access the database over the Internet, the method comprising:

searching the database for records matching financial search criteria defined by a user; and

relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one; and

reporting the matching records to the user, including at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio.

2. The method of claim 1, wherein the search criteria is suitable for being delimited between a minimum and maximum.

3. In an on-line service, a method for screening financial investment opportunities, comprising the steps of:

searching a financial database, including data for a plurality of companies, for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof;

searching an intellectual property database, including data for a plurality of companies, for data records associated with the at least one company based upon an intellectual property search criteria and retrieving the results thereof;

combining the results of the financial database searching step and the intellectual property database searching step to determine common results on a company basis; and

depicting the combined results.

4. The method of claim 3, wherein the method further comprises the step of analyzing the number of common results on a company basis to determine if the number is greater than zero, and if not

relaxing the search criteria employed in at least one of the searching steps and rerunning the searches so as to obtain a non-zero number of common results.

5. The method of claim 4, wherein the step of relaxing the search criteria is accomplished without user intervention.

6. The method of claim 3, further including the step of maintaining the financial database data records and the intellectual property database records, wherein the step includes periodically launching an automated search of network resources to locate and update financial and intellectual property information; and storing the updated information in the respective database.

7. The method of claim 6, wherein the updated information includes:

at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio, and

at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State,

Abstract, Inventor Country, Claim(s), Attorney or Agent, Description/Specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type.

8. The method of claim 3, further including the step of constructing a search query having both financial search criteria and intellectual property search criteria.

9. The method of claim 8, wherein the step of constructing a search query having both financial search criteria and intellectual property search criteria is facilitated by the step of displaying a search construction interface to a user.

10. The method of claim 4, wherein said step of combining the results of the financial database searching step and the intellectual property database searching step, further comprises accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis.

11. A system for screening financial investment opportunities, comprising:
a computer platform responsive to user input including access to at least a financial database including data records associated with a plurality of companies and an intellectual property database including data records associated with a plurality of companies,;

programmable search software, operable by said computer platform, for searching the financial database for data records associated with at least one company based upon a financial search criteria and retrieving the results thereof for storage in a first memory, said programmable search function also being employed for searching the intellectual property database for data records associated with the

at least one company based upon an intellectual property search criteria and retrieving the results thereof for storage in a second memory;

search analysis software, operable by said computer platform, for combining the results of the financial database search and the intellectual property database search to determine common results; and

a display device for depicting the common results.

12. The system of claim 11, wherein said computer platform includes a client and a server interconnected by a network, and where the financial database and the intellectual property database are stored on devices accessible through said server.

13. The system of claim 11, further including means for automatically relaxing search criteria employed by the programmable search software so as to obtain a non-zero number of search results.

14. The system of claim 11, wherein said financial database includes records having at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-1Yr, Earnings per Share Growth-1Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio, and

where said intellectual property database includes records having at least one item of intellectual property data selected from the group consisting of Patent Number, Inventor Name, Issue Date, Title, Inventor State, Abstract, Inventor Country, Claim(s), Attorney or Agent, Description/Specification, Assignee Name, Assignee State, Assignee Country, Issued US Classification, International Classification, Application Serial Number, Application Date, Primary Examiner, Assistant Examiner, Parent Case Information, Related US App. Data, US References, Reissue Data Foreign References, Foreign Priority, PCT Information, Government Interest, and Application Type.

15. The system of claim 11, wherein said display device is suitable for the display of at least one user-selectable data item to assist with the construction of a search query having both financial search criteria and intellectual property search criteria.

16. A method for processing a search request having financial search criteria, comprising:

- sending the search request to a financial database, the financial database including at least financial data for a plurality of companies;

- receiving, in response to the search request, results from the financial database having at least one data record corresponding to the financial search criteria;

- determining that the search request includes intellectual property search criteria;

- filtering said results for data records corresponding to said intellectual property search criteria; and

- presenting said filtered results.

17. A method for processing a search request having intellectual property search criteria, comprising:

- sending the search request to an intellectual property database, the intellectual property database including at least intellectual property data for a plurality of companies;

- receiving, in response to the search request, results from the intellectual property database having at least one data record corresponding to the intellectual property search criteria;

- determining that the search request includes financial search criteria;

- filtering said results for data records corresponding to said financial search criteria; and

- presenting said filtered results.

9. EVIDENCE APPENDIX:

NONE

10. RELATED PROCEEDINGS APPENDIX:

NONE